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SUPREME COURT OF THE UNITED STATES

October Term, 1962

No. 106

SCHENLEY DISTILLERS, INC., - - Petitioner,

versus

JOHN P. DANT DISTILLERY CO., and
JOHN P. DANT, JR., - - - - - Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT.

BRIEF FOR RESPONDENTS IN OPPOSITION.

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OPINIONS BELOW.

The opinion of the United States District Court for the Western District of Kentucky (Record 40a) is reported in 189 F Supp. 821. The opinion of the Court of Appeals for the Sixth Circuit is reported in 297 F. 2d 935.

JURISDICTION.

The judgment of the Court of Appeals was entered on January 4, 1962, and a Petition for Rehearing was denied on February 8, 1962. The Petition for a Writ of Certiorari was filed in this Court on May 7, 1962. Jurisdiction of this Court is invoked under 28 USC 1254 (1).

QUESTIONS PRESENTED.

1. Does John P. Dant, Jr. and does his corporation have the right to use, in a fair and reasonable manner, the personal name "John P. Dant" as a trademark, trade name and corporate name, in the same way that this personal name has been used in the whiskey business since 1890?

2. Is the trademark "John P. Dant" as used by the respondents, confusingly similar to the petitioner's registered mark "J. W. Dant"?

3. Have the respondents used the personal name "John P. Dant" as a trademark, trade name and corporate name in a fair and reasonable manner?

4. Is the petitioner estopped from questioning the right of the respondents to use the mark "John P. Dant" by the conduct of the petitioner and its predecessors in permitting the respondents and their predecessors to use the name in the whiskey business since 1890?

STATEMENT.

For more than seventy years the personal names J. W. Dant and John P. Dant have been used separately and concurrently in the whiskey business in Kentucky. The respondent John P. Dant, Jr. is the president and principal stockholder of the respondent, John P. Dant Distillery Co. His deceased father, John P. Dant, Sr., was the son of J. W. Dant, who died in 1902.

This is a suit for a judgment declaring the right of the respondents to continue to use a personal name, "John P. Dant," as a trademark, trade name and corporate name in the same way that they and their predecessors in title have used this personal name in the whiskey business since 1890. In 1953 the petitioner acquired the mark "J. W. Dant" which was registered in 1935 and petitioner claims that the federal registration of the personal name "J. W. Dant" gives it a monopoly in the use of the surname "Dant."

The Opinion of the Court of Appeals, 297 F. 2d 935, reads as follows:

> "The appellant, Schenley Distiller, Inc. is successor in title to the trade-mark 'J. W. Dant,' distillers of Kentucky whiskey from way back in 1836. The appellee, John P. Dant Distillery Co., and the third-party defendant-appellee, John P. Dant, Jr., its president, assert their right to use the trade-mark under which the whiskey of appellee's distillery is marketed and to use its corporate name. John P. Dant, Jr., is a grand-son

of J. W. Dant and a nephew of the latter's son, George W. Dant—the family's early Kentucky distillers.

"In this action, tried without the intervention of a jury, the United States District Court held that the appellee is entitled to use the name 'John P. Dant' in its corporate name, and is entitled, as exclusive licensee of the owner John P. Dant, Jr., to use the name and mark 'John P. Dant' in the manner and style in which such name and mark have been used in the whiskey business for many years. The Court held further that the trade-mark 'John P. Dant' is not confusingly similar to appellant's trade-mark 'J. W. Dant.'

"District Judge Shelbourne, in a Memorandum (published in 189 F. Supp. 821) consisting of Findings of Fact, supported by substantial evidence and not clearly erroneous, and appropriate and correct Conclusions of Law, set forth succinctly the basis upon which he reached his conclusion. The Conclusions of law are documented with appropriate authority, including several decisions of this court.

"Inasmuch as the findings and conclusions are published, as shown, supra, and are entirely adequate, we find no occasion to re-write or add to Judge Shelbourne's excellent work,

"Accordingly, the judgment of the District Court is affirmed."

Both decisions below turn upon the facts, and the petition in effect asks this Court to set aside the findings of fact made by the District Court and affirmed by the Court of Appeals.

SUMMARY OF ARGUMENT.

1. The decisions below are correct and there is no occasion for further review.

2. This is not a case for review by certiorari under Rule 19 (b) of the Rules of this Court.

ARGUMENT.

I.

The Decisions Below Are Correct.

The record in this case contains no evidence that the respondents have used the name and mark "John P. Dant" in an unfair manner, or that they have done anything to cause the public to believe that their product is that of the petitioner, or that there has been any confusion or mistake on the part of the public regarding the products of the respondents and the petitioner.

Both courts below specifically found that the trademark "John P. Dant" as used by the respondents is not confusingly similar to the petitioner's registered mark "J. W. Dant".

This is the only finding that could have been reached on the record in this case. There is not one word in the evidence to the effect that the marks "John P. Dant" and "J. W. Dant" are at all similar, that there has ever been any confusion, or that there is any likelihood of any confusion of these marks.

An examination of the two marks currently in use by the parties will demonstrate to the Court, upon its own visual comparison, that these marks can be readily distinguished by anyone who looks at them. The mark "J. W. Dant" (23b, 147a, 265a) is in script letters and the letters "J. W. D." are the dominant part of the mark and occupy approximately three-fourths of the entire space allotted to the mark. The mark "J. W. Dant" which is in block letters (149a) has not been used. The mark "John P. Dant" (21b, 123a) is in Old English letters and the "John P." is more prominent than the word Dant. The mere fact that the same surname "Dant" appears in the two marks, does not indicate a confusing similarity.

Since there is no probability of confusion, there can be no infringement of petitioner's mark. Actually, the petitioner does not base its case on the ground of confusion between the marks as they have been used by the parties. Counsel for the petitioner claims that any use of the name Dant by another is in itself an infringement. The decisions of this Court do not support this position.

The right of an individual to use, in a fair and reasonable manner, his own name in business, has been well settled since this Court in *Brown Chemical Co.* v. *Meyer* (1891), 139 U. S. 540, 11 S. Ct. 625, 35 L. Ed. 247, said:

> "It is hardly necessary to say that an ordinary surname cannot be appropriated as a trade-mark by any one person against others of the same name, who are using it for a legitimate purpose; * * *."

The *Brown Chemical* decision was reaffirmed by this Court in another leading case, in which the same surname "Remington" was used by competing businesses and on identical products. *Howe Scale Co.* v. *Wyckoff, Seamans & Benedict* (1905), 198 U. S. 118, 25 S. Ct. 609, 49 L. Ed. 972. Here counsel made the same arguments that counsel for the petitioner make in the present case, and this Court said:

> "But it is well settled that a personal name cannot be exclusively appropriated by any one as against others having a right to use it; and as the name 'Remington' is an ordinary family surname, it was manifestly incapable of exclusive appropriation as a valid trademark, and its registration as such could not in itself give it validity.
>
> * * * * * * *
>
> "Having the right to that use, courts will not interfere where the only confusion, if any, results from a similarity of the names and not from the manner of the use."

In quoting from *L. E. Waterman Co.* v. *Modern Pen Co.* (1914), 235 U. S. 88, 35 S. Ct. 91, 59 L. Ed. 242, the text *Nims, Unfair Competition and Trade-Marks* (1947), page 1177, says:

> "The remedy for unfair competition by use of corporate names is largely the same as the remedy for unfair competition by the use of a personal name or the name of a firm. 'There is no distinction between corporations and natural persons in the principle, which is to prevent fraud.' An individual who has been doing business under his own name is not deprived of the right to use

> his own name because he brings a partner into his business, or incorporates. This is the history of many corporations having family names; and where these are the facts, the corporation is under no greater liability and is not subject to any more severe penalty than would have fallen on the incorporator of that same name 'had he gone on alone.'"

Counsel for the petitioner say that the Court repudiated the above decisions by its decision in *Thaddeus Davids Co.* v. *Davids* (1914), 233 U. S. 461, 34 S. Ct. 648, 58 L. Ed. 1046. Certainly there is nothing to that effect in the opinion and the decision in the *Davids* case is easily distiguished from the instant case.

In the *Davids* case the petitioner had registered the trademark "Davids". In the instant case the petitioner has registered the name "J. W. Dant", not the name "Dant". In that case the evidence established a "colorable imitation", in this case there is no evidence of "colorable imitation". In that case the respondent was not prohibited from all trademark use of the family name, but it was simply ordered not to use its trademark in the manner found to be a simulation of petitioner's mark. The opinion in the *Davids* case reads in part as follows:

> "It would seem to be clear, for example, that the registration for which the statute provides was not designed to confer a monopoly of the use of surnames, or of geographical names, as such.
>
> * * * * * * * *

> "It follows that where the mark consists of a surname a person having the same name and using it in his own business, although dealing in similar goods, would not be an infringer, provided that the name was not used in a manner tending to mislead, and it was clearly made to appear that the goods were his own, and not those of the registrant."

See also, *Armstrong Paints Works* v. *Nu-Enamel Corp.* (1938), 305 U. S. 315, 59 S. Ct. 191, 83 L. Ed. 195; *Crane Co.* v. *Crane Heating & Air Conditioning Co.* (CA 6, 1962), 299 F. 2d 577, and *County Distillers Products* v. *Samuel, Inc.*, 309 Ky. 262, 217 S. W. 2d 216.

During the period from 1890 to 1951 the petitioner's predecessors made no objection whatever to the use of the name and mark "John P. Dant" by the respondents and their predecessors. In this case we have not only prolonged unexplained delay, with knowledge, but affirmative acts which create estoppel by acquiescence. *Procter & Gamble Co.* v. *J. L. Prescott Co.* (CA 3), 102 F. 2d 773. Therefore, if the marks "John P. Dant" and "J. W. Dant" were confusingly similar, which they are not, the petitioner would be estopped from interfering with the respondents' use of their name and mark.

We submit that the decisions below are correct and that there is no occasion for further review.

II.

This Is Not a Proper Case for Certiorari.

Since the decisions below are in accord with the well settled principles of law applicable to this case, the only questions presented by the petition are questions of fact.

In many opinions it has been said for this Court: "We do not grant a certiorari to review evidence and discuss specific facts." *United States* v. *Johnston*, 268 U. S. 220, 69 L. Ed. 925, 45 S. Ct. 496.

In *Magnum Import Co.* v. *Coty*, 262 U. S. 159, 67 L. Ed. 922, 43 S. Ct. 531, it is said:

> "The jurisdiction to bring up cases by certiorari from the circuit court of appeals was given for two purposes: first, to secure uniformity of decision between those courts in the nine circuits; and, second, to bring up cases involving questions of importance which it is in the public interest to have decided by this court of last resort. The jurisdiction was not conferred upon this court merely to give the defeated party in the circuit court of appeals another hearing. Our experience shows that 80 per cent of those who petition for certiorari do not appreciate these necessary limitations upon our issue of the writ."

Clearly this case does not involve "questions of importance which it is in the public interest to have decided by this Court of last resort," and the real questions presented are not among those enumerated in Rule 19, Paragraph (b) of the Rules of this Court.

As said in 48 Harvard Law Review 238, 274:

> "To scores of petitioners each year any asserted error in the decision of a case, however minute and of whatever character, is such a departure 'from the accepted and usual court of judicial proceedings' as to call for an exercise of the Supreme Court's power of supervision. Of course, the reason refers neither to errors of law nor to minor departures from customary practice. It refers to matters of major concern to the integrity of the judicial process."

See also 68 Harvard Law Review 54.

It is obvious that the petition in this case does not present any question of major concern to the integrity of the judicial process. Therefore this is not a proper case for the issuance of a writ of certiorari.

CONCLUSION.

The petition should be denied.

Respectfully submitted,

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